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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,423	12/01/2006	Malcolm Tom McKechnie	102792-547 (11018P1 US)	8984
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PARFOMAK, ANDREW N. NORRIS MCLAUGHLIN & MARCUS PA 875 THIRD AVE, 8TH FLOOR NEW YORK, NY 10022			EXAMINER DOUYON, LORNA M	
			ART UNIT	PAPER NUMBER
			1796	
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			09/14/2010 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/574,423

Applicant(s)

MCKECHNIE, MALCOLM TOM

Examiner

Lorna M. Douyon

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9-15 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-15, 18-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. The **finality** of the rejection of the last Office action is withdrawn in view of the newly found art as described below.
2. This action is responsive to the amendment filed on August 30, 2010.
3. Claims 1-6, 9-15, 18-23 are pending. Claims 7, 8, 16 and 17 are cancelled. Claim 1 is currently amended.
4. It is again suggested that a **"Brief Description of the Drawings"** be added to the specification in the order as described in the previous office action.
5. The rejection of claims 1-6, 9-15, 17 and 23 under 35 U.S.C. 103(a) as being unpatentable over Lorenzi et al. (US Patent No. 6,322,801) is withdrawn in view of Applicants' amendment.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claims **18-22 stand rejected** under 35 U.S.C. 103(a) as being unpatentable over Lorenzi et al. (US Patent No. 6,322,801), hereinafter "Lorenzi".

Lorenzi teaches a substantially dry, disposable personal care article suitable for cleansing wherein the article comprises: a) a water insoluble substrate comprising a first layer that includes a nonwoven ply and a polymeric net arranged with the nonwoven ply; and b) a cleansing component disposed adjacent to said first layer of a lathering surfactant (see abstract). Zeolites and other compounds which react exothermically when combined with water may also be optionally included in the articles (see col. 31, lines 60-63). The articles comprise from about 10% to about 1,000%, preferably from about 50% to about 600%, and more preferably from about 100% to about 250%, based on the weight of the water insoluble substrate, of the surfactant, and the articles preferably comprise at least about 1 gram, by weight of the water insoluble substrate, of a surfactant (see col. 10, lines 31-45, claim 1). In Examples 18-19, Lorenzi teaches skin cleansing and conditioning articles, wherein the cleansing component of Example 1, which comprises a surfactant, is three-roll milled with aluminosilicate (which generates heat due to an exothermic reaction upon exposure to water) in a ratio of 1:1 and 10 grams of the cleansing component is applied to one side of a layer of batting, sealed with a second nonwoven layer, and thereafter 4 grams of a skin conditioning composition is applied to the lofty batting side, and the product is stored in a sealed, metallized film package until ready for use (see col. 46, line 64 to col. 47, line 37). Even though Lorenzi does not disclose an article adapted for cleaning a surface of an inanimate object, it has been held that the recitation that an element is "adapted to" perform or is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. The recitation of a new intended use for an old

product does not make a claim to that old product patentable, see *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). Lorenzi, however, fails to specifically disclose the loading of the cleaning agent on the substrate in amounts as those recited.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the loading of the cleaning agent on the substrate through routine experimentation for best results. As to optimization results, a patent will not be granted based upon the optimization of result effective variables when the optimization is obtained through routine experimentation unless there is a showing of unexpected results which properly rebuts the *prima facie* case of obviousness. See *In re Boesch*, 617 F.2d 272,276,205 USPQ 215,219 (CCPA 1980). See also *In re Woodruff* 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F2d 454,456,105 USPQ 233,235 (CCPA 1955).

8. Claims 1-6, 9-14, 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Verdrel-Lahaxe et al. (US 2002/0032135), hereinafter "Verdrel-Lahaxe, in view of Shaw et al. (US 2002/0107156), hereinafter "Shaw".

Verdrel-Lahaxe teaches an article comprising a water-insoluble substrate; and an exothermic composition, comprising: at least one zeolite (which reads on the heat generating agent), at least one surfactant (which reads on the cleaning agent), at least one magnesium or calcium halide (also reads on the heat generating agent); and a physiologically acceptable anhydrous medium (see claim 25). The composition, which is homogeneous, and in the form of a translucent to opaque gel, cream, paste or powder,

is impregnated on a wipe (see paragraph [0059] on page 2; which meets claims 4 and 14). The water-insoluble substrate may be a sponge or a wipe, for example a wipe from nonwoven material, the wipe being dry or humid (see paragraph [0090] on page 4) (which meets claims 5 and 10). The expression "exothermic composition" means a composition such that the user experiences a heating sensation when the composition is applied to the skin, and it is a composition whose temperature in the presence of water (water added during its use or the water present in the skin) may instantaneously rise by several degrees (one to twenty degrees), see paragraph [0056] on page 2 (which meets claims 2-3). The zeolites include activated zeolites (see paragraph [0065] on page 2, for example, the zeolites disclosed in U.S. Pat. No. 4,626,550, incorporated herein in its entirety by reference (see paragraph [0069] on page 3), which discloses that activated zeolites are dehydrated zeolites (see col. 5, lines 39-40 of US '550) (which meets claims 11-13), which releases sufficient heat upon hydration to produce the desired warming effect (see col. 2, lines 14-16 of US 550). The amount of zeolites generally ranges from 5% to 95% by weight (see paragraph [0073] on page 3) (which meets claim 6). The surfactant is preferably a cleansing and/or foaming surfactant which is chosen from nonionic surfactants, anionic surfactants and amphoteric surfactants, and mixtures thereof, and the amount of surfactant(s) may range from 0.5 to 20% by weight, preferably from 1% to 15% by weight of active material relative to the total weight of the composition (see paragraph [0074] on page 3). Even though Verdrel-Lahaxe does not disclose an article adapted for cleaning a surface of an inanimate object (as required in independent claims 1 and 18), or an article adapted to provide for

substantially streak free cleaning of inanimate surface (as required in claim 23), it has been held that the recitation that an element is "adapted to" perform or is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. The recitation of a new intended use for an old product does not make a claim to that old product patentable, see *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). Verdrel-Lahaxe, however, fails to specifically disclose the loading of the cleaning agent on the substrate in amounts as those required in claims 1 and 18-22, and a germicidal cationic surfactant as required in claim 9.

Shaw, an analogous art, teaches the equivalency of anionic, nonionic or amphoteric surfactants with cationic surfactants (see paragraph [0041] on page 2). Examples of cationic surfactants are quaternary amines (see paragraph [0090] on page 6), which are also germicidal. Shaw also teaches that when a similar cleansing composition is disposed on the water-insoluble substrate, the articles comprise from about 0.5% to about 3,000% based on the weight of the untreated water insoluble substrate, of the surfactant composition. Preferably, the article comprises at least about 1 gram, by weight of the treated water insoluble substrate, of a surfactant (see paragraph [0116] on page 7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have disposed or loaded the cleansing composition of Verdrel-Lahaxe into the wipe in its optimum proportions because it is known from Shaw to load a similar article in the range from about 0.5% to about 3,000% based on the weight of the untreated water insoluble substrate, of the surfactant composition, or at least about

1 gram, by weight of the treated water insoluble substrate, of a surfactant, hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select the portion of the prior art's range which is within the range of applicant's claims because it has been held to be obvious to select a value in a known range by optimization for the best results. As to optimization results, a patent will not be granted based upon the optimization of result effective variables when the optimization is obtained through routine experimentation unless there is a showing of unexpected results which properly rebuts the prima facie case of obviousness. See *In re Boesch*, 627 F.2d 272,276,205 USPQ 215,219 (CCPA 1980). See also *In re Woodruff* 919 F.2d 1575, 1578,16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F.2d 454,456,105 USPQ 233,235 (CCPA 1955).

With respect to the germicidal cationic surfactant, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted the anionic, nonionic or amphoteric surfactants of Verdrel-Lahaxe with a cationic surfactant (which is also germicidal) because the substitution of art recognized equivalents as shown by Shaw is within the level of ordinary skill in the art.

9. Claims 1-6, 9-10, 14, 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al. (US 2002/0107156), hereinafter "Shaw".

Shaw teaches an article for personal cleansing which comprises a water insoluble substrate with a cleansing composition (see paragraph [0099] on page 7), wherein the cleansing composition in paste form comprises one or more surfactants

selected from the group consisting of anionic surfactants, amphoteric surfactants, nonionic surfactants, cationic surfactants, and mixtures thereof (see paragraph [0009] on page 1). Examples of cationic surfactants are quaternary amines (see paragraph [0090] on page 6), which are also germicidal (meets claim 9). The cleaning composition may contain a variety of other components such as are conventionally used in a given product type provided that they do not unacceptably alter the benefits of the invention (see paragraph [0127] on page 8), examples include additional antimicrobial agents, e.g., quaternium-15 (which also reads on claim 9) and particular zeolites (which read on the heat generating agent of claim 1), and such materials can be incorporated into the cleansing composition from about 0.01% to about 40% by weight (which meets claim 6). Additionally, these components can be applied to the substrate sheet as a deposit separate from that of the cleansing composition (see paragraph [0128] on page 8) (which meets claims 4 and 14). The water insoluble substrate comprises at least one layer, a substrate sheet to which the paste form cleansing composition is applied (see paragraph [0099] on page 7). Suitable materials for use as sheets of the water insoluble substrate include nonwovens, wovens or sponges (see paragraph [0121] on page 8) (which meets claims 5 and 10). Shaw also teaches that when a similar cleansing composition is disposed on the water-insoluble substrate, the articles comprise from about 0.5% to about 3,000% based on the weight of the untreated water insoluble substrate, of the surfactant composition. Preferably, the article comprises at least about 1 gram, by weight of the treated water insoluble substrate, of a surfactant (see paragraph [0116] on page 7). The articles are intended to be wetted with water prior to

use, and the article is wetted by immersion in water or by placing it under a stream of water (see paragraph [0163] on page 10), which meet claims 2-3). Shaw, however, fails to specifically disclose the loading of the cleaning agent on the substrate in amounts as those required in claims 1 and 18-22.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the portion of the prior art's range which is within the range of applicant's claims because it has been held to be obvious to select a value in a known range by optimization for the best results. As to optimization results, a patent will not be granted based upon the optimization of result effective variables when the optimization is obtained through routine experimentation unless there is a showing of unexpected results which properly rebuts the prima facie case of obviousness. See *In re Boesch*, 627 F.2d 272,276,205 USPQ 215,219 (CCPA 1980). See also *In re Woodruff* 919 F.2d 1575, 1578,16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990), and *In re Aller*, 220 F.2d 454,456,105 USPQ 233,235 (CCPA 1955).

In addition, a *prima facie* case of obviousness exists because the claimed ranges "overlap or lie inside ranges disclosed by the prior art", see *In re Wertheim*, 541 F.2d 257,191 USPQ 90 (CCPA 1976; *In re Woodruff*; 919 F.2d 1575,16USPQ2d 1934 (Fed. Cir. 1990). See MFEP 2131.03 and MPEP 2144.05I.

10. Claims 11, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw as applied to the above claims, and further in view of Verdrel-Lahaxe.

Shaw teaches the features as described above. Shaw, however, fails to specifically disclose the zeolites as being dehydrated.

Verdrel-Lahaxe teaches the features as described above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the zeolite of Shaw into dehydrated zeolites because such dehydrated zeolites will provide sufficient heat upon hydration to produce the desired warming effect as taught by Verdrel-Lahaxe.

11. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw, alone, **or** Verdrel-Lahaxe and Shaw as applied to the above claims, and further in view of Telesca et al. (US Patent No. 6,412,634), hereinafter "Telesca".

Shaw, alone, **or** Verdrel-Lahaxe and Shaw teach the features as described above. Shaw, alone, **or** Verdrel-Lahaxe and Shaw, however, fail to specifically disclose a water-tight container which optionally includes a resealable opening to accommodate the article in a dry environment.

Telesca, an analogous art, teaches a towelette dispenser which can maintain a stack of towelettes hermetically sealed from the atmosphere (hence, water-tight) during extended periods of time, especially after multiple openings for dispensing of individual tissues (see col. 2, lines 12-16; col. 1, lines 13-26). The towelette dispenser also includes a reusable outer container which after having dispensed most of a stack of towelettes is substantially as efficiently resealable as in its initially fully towelette filled position (see col. 2, lines 17-21; Figure 1). The dispenser provides for an improved,

more efficient mechanism for ensuring good seals to prevent moisture or solvents from transferring in either direction through the seals (see col. 2, lines 8-11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have packaged the wipes of Shaw, alone, or Verdrel-Lahaxe and Shaw into the dispenser of Telesca because such dispenser will provide for an improved, more efficient mechanism for ensuring good seals to prevent moisture or solvents from transferring in either direction through the seals.

Response to Arguments

12. Applicants' arguments filed on August 30, 2010 regarding the amount of surfactant in the cleaning article in the present amended claim 1, whose limitations were present in previous claim 17, are persuasive, thus, the obviousness rejection of claims 1-6, 9-15, 17 and 23 is withdrawn. Independent claim 18 and dependent claims 19-22, which do not require the amount of surfactant as recited in amended claim 1, rather, the loading of the surfactant or cleaning agent on the cleaning substrate is maintained because Lorenzi teaches such loading which overlaps those recited, as stated in paragraph 7 above. Hence, the obviousness rejection of claims 18-22 over Lorenzi is proper and is maintained.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lorna M. Douyon whose telephone number is 571-272-1313. The examiner can normally be reached on Mondays-Fridays 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lorna M Douyon/
Primary Examiner, Art Unit 1796

